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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/606,172	06/24/2003	David Thomason	CH2M.33	1498

25871 7590 09/15/2006

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EXAMINER

GRAYSAY, TAMARA L

ART UNIT	PAPER NUMBER
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3636

DATE MAILED: 09/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/606,172

Applicant(s)

THOMASON ET AL.

Examiner

Tamara L. Graysay

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 September 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 June 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Preliminary Matters

1. The response filed 08 September 2006 fails to address the objections made regarding the drawings. Therefore, the objection is repeated below. The response to this Office action must *fully* address the drawing objection repeated below.
2. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.

Drawings

3. The drawings are objected to because of the following:
 - a. FIG. 2: The horizontally oriented cross-section line 11-11 is not properly oriented because the cross-sectional view of FIG. 11 depicts a vertical cross section of the column and slab.
 - b. FIG. 3: The lead line for reference character 34 at the right side of the figure is not directed to the top surface of the plate 32.
 - c. FIG. 11 and 12: Reference characters 180 and 183 are both used to depict the same element, the vertical reinforcing.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will

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be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-13 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling.

The rectangular concrete “tank” product claims that do not include a slab having a rectangular slab plate defining at least four side walls and at least four side panels are not enabled by the disclosure because those elements (a rectangular slab plate and four side panels) and the associated liquid-tight welds between each adjacent element, are critical or essential to the practice of the invention, but not included in the claim(s). See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976).

First, the claim is directed to a “tank” which requires the rectangular slab plate, at least four side walls, and at least four side panels. Without recitation of the noted elements, there is no “tank” as set forth in the preamble.

Second, there are several instances in the amendment filed 31 October 2005 and/or specification related to the criticality of the rectangular concrete tank structure. For example, the criticality of the rectangular slab plate and four side panels is relied upon in the amendment filed 31 October 2005, e.g., at page 2, third paragraph (a tank for containing liquids which is rectangular and liquid-tight), and page 3, first paragraph

(liquid-tight welds for all horizontal and vertical welds). The criticality is also supported by the specification, e.g., on pages 2 and 3 (rectangular wall outline), and page 7 (at a minimum, the tilt-up concrete tank 10 consists of the bottom slab 12 and side walls 14, 16, 18, 20).

In conclusion, the claims do not include all of the critical elements of the invention that are essential for a concrete tank.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As argued in the amendment filed 31 October 2005, applicant's intent and the claim preamble are a rectangular concrete tank, not just a connection for a tank.

Therefore, the body of the claim fails to include the minimum elements and associated connections required for a rectangular tank. Specifically, the claim is limited to one sidewall linear slab plate, a plurality of side panels having side plates and a bottom plate, and two connections (one between the bottom plate and slab plate and one between two adjacent side plates). Such an arrangement fails to define a rectangular concrete tank, as set forth in the preamble of the claim. Further, the structure lacks the minimum four side panels (a minimum requirement as noted in the amendment and supported by

specification) and liquid-tight welds between all bottom plates and the slab plate and liquid-tight welds between all adjacent side plates in order to form a rectangular tank.

Response to Arguments

6. Applicant's arguments filed 08 September 2006 have been fully considered but they are not persuasive.

In response to applicant's argument that *In re Mayhew* is misapplied and that the holding is strictly limited to cases where failure to recite a limitation renders a claim itself "wholly inoperative," the examiner points out that the holding has been applied to the claims of the present application in the same manner for the same reason. In the present application, the claim is directed to a rectangular concrete (or rectangular tilt-up) tank as recited in the preamble of claims 1-13. Such tilt-up construction requires a rectangular slab plate defining four side walls and four side panels. The unclaimed elements are necessary to support an operative invention, i.e., a tank, as set forth in the preamble and as mentioned in the paragraph spanning pages 5 and 6. The statement that an operative tank can result regardless of the manner of construction of the remaining walls is not consistent with the claim which is directed to a tank. Further, applicant has not pointed out where in the specification support can be found for a "rectangular concrete tank" or "rectangular tilt-up tank" having a slab plate defining one side wall in combination with one side panel.

In response to applicant's argument that the examiner is attempting to limit the claims to a preferred embodiment, the examiner points out that it is applicant's claims

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that limit the invention, i.e., the claim is limited to a rectangular concrete tank. The indefiniteness arises because a rectangular concrete tilt-up tank does not have a slab plate defining one side wall together with one side panel. As presented in the preamble, applicant fully intends to limit the claim to a tank, but fails to recited elements necessary to form a tank that is operative.

In response to applicant's argument that applicant's argument cannot "transform an omitted element into something necessary to define an operative invention," the examiner points out that the arguments filed 31 October 2005 (as well as the arguments filed 08 September 2006) are secondary considerations that support the examiner's position that the claims as presented are not limited to anything less than a tank. The examiner has referred not only to the arguments but also to the specification which requires a slab having a rectangular slab plate defining at least four side walls and at least four side panels. The arguments have not transformed an omitted element into something necessary to define an operative invention, but they are secondary considerations that fully support the examiner's reasonable interpretation of the claim language in light of the specification and the record as a whole.

In response to applicant's argument that the examiner has impermissibly discerned an intended scope of the claim, the examiner has pointed specifically to the claim language and the interpretation given the language in the claim preamble. In other words, the claims are drawn to a tank, but essential elements that are necessary to form a tank are omitted from the body of the claim. Therefore, the claim is indefinite.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

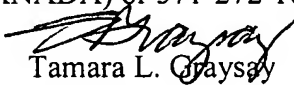
- Bloxom (US-3555763) teaches forming walls with prefabricated panels including welding the wall joints.
- Kruger (US-4865213) teaches tensioning cables (42) in a wall structure.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamara L. Graysay whose telephone number is 571-272-6728. The examiner can normally be reached on Mon - Fri from 8:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter M. Cuomo, can be reached on 571-272-6856. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Tamara L. Graysay
Examiner
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